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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,339	12/02/2003	Takaaki Matsubayashi	50002-019	1352
<div>7590 01/27/2010 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096</div>				
EXAMINER				
MAPLES, JOHN S				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
01/27/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,339

Applicant(s)

MATSUBAYASHI ET AL.

Examiner

John S. Maples

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-51 is/are pending in the application.
- 4a) Of the above claim(s) 37-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35, 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for disposing the oxidizer gas inlet header on the second surface of the first plate when the oxidizer gas outlet is on the second surface of the first plate, does not reasonably provide enablement for disposing the oxidizer gas inlet header on the second surface of the first plate when the oxidizer gas outlet is on the third surface of the second plate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.
(New Rejection)

Claim 35, lines 9-13 and 20, recite disposing the oxidizer gas inlet header on the second surface of the first plate when the oxidizer gas outlet is on the third surface of the second plate. The present specification including the drawings does not provide support for this feature. The present specification and drawings do, however, provide support for disposing the oxidizer gas inlet header on the second surface of the first plate when the oxidizer gas outlet is on the second surface of the first plate. Amendment of claim 35 is required to conform the claimed subject matter in line with the present specification.

Claim 36, dependent on claim 35, falls therewith.

3. Claims 35 and 36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for heating at least one of the fuel gas inlet header and the oxidizer gas inlet header with the heat medium when the heat medium inlet header or heat medium outlet header are located on the same plate on the side opposite at least one of the fuel gas inlet header or the oxidizer gas inlet header, does not reasonably provide enablement for heating at least one of the fuel gas inlet header and the oxidizer gas inlet header with the heat medium when the heat medium is located on a different plate than either of the fuel gas inlet header and the oxidizer gas inlet header. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. (New Rejection)

The present specification and drawings set forth heating at least one of the fuel gas inlet header and the oxidizer gas inlet header with the heat medium when the heat medium inlet header or heat medium outlet header are located on the same plate on the side opposite at least one of the fuel gas inlet header or the oxidizer gas inlet header. Reference is made to the respective paragraphs beginning on page 16, line 11 and page 20, line 21. The present specification including the drawings does not, however, support heating at least one of the fuel gas inlet header and the oxidizer gas inlet header with the heat medium when the heat medium is located on a different plate than either of the fuel gas inlet header and the oxidizer gas inlet header. Amendment of claim 35 is required to conform the claimed subject matter in line with the present specification.

Claim 36, dependent on claim 35, falls therewith.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (New Rejection)

In line 2 of claim 36, it is unclear which "gas inlet header" is being referenced by this language appearing in this portion of this claim?

6. In view of the above 35 USC 112, first and second paragraph deficiencies, it was still not possible to determine the metes and bounds of applicant's invention and so a prior art search was not conducted.

7. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is 571-272-1287. The examiner can normally be reached on Monday-Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John S. Maples/

John S. Maples
Primary Examiner
Art Unit 1795

JSM/1-22-2010